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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,739	01/16/2004	Andrew G. Carlidge	PRP112US	6371
23623	7590	01/09/2006	EXAMINER	
AMIN & TUROCY, LLP 1900 EAST 9TH STREET, NATIONAL CITY CENTER 24TH FLOOR, CLEVELAND, OH 44114			LIVEDALEN, BRIAN J	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/758,739	Applicant(s) CARTLIDGE ET AL.	
	Examiner Brian J. Livedalen	Art Unit 2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/16/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6, 8, 9, and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, and 16 of copending Application No. 10/189326 hereinafter referred to as '326.

In regard to claim 1, claim 1 of '326 recites a sensor with multiple receptors (pixels); and an optical device that provides mapping of receptor size to about a size of a diffraction-limited object appearing in the object field of view. '326 only fails to mention the mapping to the object field of view. However, it would be obvious to map the entire field of view in order to uniformly image the entire field of view.

In regard to claim 2, claim 1 of '326 recites an optical device to direct light, which is equivalent to a light source.

In regard to claim 6, claim 16 of '326 recites using the system in a camera.

In regard to claim 8, claim 16 of '326 recites using the system for medical applications.

In regard to claim 9, claim 15 of '326 recites an automatic adjustment.

In regard to claim 13, claim 1 of '326 recites a sensor with multiple receptors (pixels); and an optical device that provides mapping of receptor size to about a size of a diffraction-limited object appearing in the object field of view. '326 fails to mention the mapping to the object field of view and the optical system being a lens. However, it would be obvious to map the entire field of view in order to uniformly image the entire field of view and it would be obvious to map a receptor size by using a lens.

This is a provisional obviousness-type double patenting rejection.

Claim Objections

Claim 4 recites the limitation "the enclosure." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Vock et al. (5798519).

In regard to claims 1 and 13, Vock discloses (fig. 4) a portable imaging system having a sensor (fig. 5, 100) having a plurality of pixels (77b); and an optical system (lens configuration) (71) that maps the plurality of pixels to an object field of view (column 3, lines 45-51); the plurality of pixels are scaled to about the size of a diffraction-limited spot (73) defined by the optical system (column 9, line 33 – column 10, line 7).

In regard to claims 2-4, 6-10 and 14, Vock discloses (fig. 7) a light source (illumination module) (182), an enclosure (fig. 5, 100) for the optical system and sensor, a processor (114, frame grabber) for operation in the enclosure to facilitate image generation. Vock further discloses that the sensor is associated with a digital camera (abstract) wherein the sensor is adapted for at least red, green, blue and at least another color (column 26, lines 54-57). Because Vock discloses using a color filter to match the sensor to a desired color, examiner is assuming that the sensor detects all colors. Vock discloses (fig. 7) a power supply (168) (column 13, lines 45-47). Power sources are either AC or DC so it is assumed that Vock meets the limitation of the claim. Because the reference discloses the structure of the claimed invention, it is assumed that it can be applied to medical use.

Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al. (5769076).

In regard to claim 15, Maekawa discloses (fig. 6) a microscopic imaging system having a light source (20) to illuminate a specimen; a diffuser (26) associated with the light source; an optical medium (38b) to magnify the specimen; and a sensor (40a) having a plurality of pixels for receiving light from the specimen in accordance with the optical medium (column 6, 12-32).

In regard to claim 16, Maekawa discloses a memory to store information from the pixels (column 6, 56-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vock et al. (5798519) as applied to claim 1, and in view of Drobot et al. (20020110077).

In regard to claim 5, Vock discloses a portable imaging system. Vock fails to disclose using a holographic element to facilitate generation of an image. However, Drobot discloses an imaging system using a holographic lens (page 7, paragraph 0055). It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to use a holographic element for imaging in order to more efficiently detect the light from the object.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vock et al. (5798519) as applied to claim 1, and in view of Soenksen (6711283).

In regard to claims 11 and 12, Vock discloses a portable imaging system. Vock fails to disclose transferring digital images by a Firewire port. However, Soenksen discloses an imaging system that sends images to another location via a Firewire port (column 12, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a port such as a Firewire port in order to store the digital images or to communicate them to a user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Livedalen whose telephone number is (571) 272-2715. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bjl



THANH X. LUU
PATENT EXAMINER